UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		09/488,969	BAER ET AL.
		Examiner	Art Unit
		Maikhanh Nguyen	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 October 2007_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-15_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the Amendment filed 10/05/2007.

   Claims 1-15 are presented for examination. Claims 1, 6 and 11 have been amended.

   Claims 1, 6 and 11 are independent claims.

Claim Objections

2.   Claims 1, 6 and 11 are objected to because of the following informalities:

   • the phrase "the content objects" (claim 1, line 11) should read "the content
     object";

   • the phrase "the content objects" (claim 6, line 12) should read "the content
     object"; and

   • the phrase "the content objects" (claim 11, line 10) should read "the content
     object.

   Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to independent claims 1, 6 and 11, "the designations" lacks antecedent basis. The Claims have no "designations" term that defines or supports the given reference.

Dependent claims 2-5, 7-10, and 12-14 are rejected for fully incorporating the deficiencies of their base claim.

Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b),by another filed in the United States before the invention by the applicant for patent or (2)a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

application filed under the treaty defined in section 351(a)shall have the effects for the purposes of this subsection of
an application filed in the United States only if the international application designated the United States and was
published under Article 21(2)of such treaty in the English language; or " (Emphasis added.)

Claims 1-3, 6-8, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by

Mortimer et al. (US Patent No. 6091930, filed 03/04/1997).

As to claims 1, 6, and 11:

Mortimer teaches a method, program storage device, and system for providing

prerequisite checking in a system for creating a content object *(generates a professor*

CITbook 40), being one of a book, a document, a collection of images, a collection of

musical selections, a video and a multimedia object, from a plurality of individual content

entities including content for the content object and stored in a data repository as a

plurality of individual file objects, some of the content entities being prerequisites to

others of the content entities and the content object being defined by a list indicating the

content entities from the data repository specified by a user for the content object *[see the*

Abstract and col. 6, lines 15-22], the method comprising the steps of:

- adding or removing a selected content entity to or from the list to add or remove

  the selected content entity to or from the content object *(col. 18, line 61-col.19,*

  line 28 and col. 22, lines 37-52 -> the professor CITbook 40, for a specified

  group of chapters, links are created in a predetermined or preferred sequence

  linking the material together to define a primary route through the chapters

similar to a course syllabus ... the form of pointers, addresses, indexes, linked

lists, trees, or any other data ... connect a series of topics or chapters of a

selected subject in a predetermined primary sequence in order to simulate a

sequence of an actual text book ... focus on only selected topic which are deemed

important for a particular class), wherein a prerequisite content entity is

associated with another content entity and designated for inclusion in the content

objects for which that other content entity is selected and placed *(col. 6, lines 54-*

67, col. 7, line 39 - col. 8, line 67, col. 15, line 37-col. 16, line 12 -> a set of

predefined data-entry rules 74 or specifications for the document-entry ...

specifying a selected data format which the data must comply with before it is

accepted ... provide for formatting, organizing, categorizing and integrating the

inputted material into a professor CITbook ... generating a set of rules and

restrictions with which inputted information must comply ... the rules are easily

complied with allowing the user to focus on entering the content of the material.

With the selected entry rules, all information inputted into the interactive system

will have a standard and uniform format) and wherein the designations

prerequisite content entities for content entities within the data repository are

stored external of the individual file objects containing the content entities *(col.*

16, lines 25-47 -> assembles files containing audio/video clips, images,

illustrations, simulations, embedded or background text, and the main text which

is the controlling component of the material, the expert contribution manager 210

links, stores, and formats the new material and incorporates it into the student

CITbook 50 ... images, videos, and simulations will still be edited and stored

elsewhere, but the expert contribution manage);

- examining the stored associations between content entities and prerequisite

  content entities and determining if the selected content entity has any prerequisite

  content entities designated for that content entity *(col. 7, lines 38-62; col. 8, lines*

  39-51; and col.13, lines 18-32 -> data including text, images, illustrations,

  simulations, audio and video for inclusions ... determine which portions of the

  collected data are well-accepted among experts in the relevant field. The well-

  accepted data includes data which is believed to be "true" at the time of review

  and of course includes established proven theories and topics. The set of well-

  accepted data is considered the "truth" in the relevant field of study and forms a

  primary knowledge base of the professor CITbook 40. Preferably, a separate

  professor CITbook 40 is generated for each selected scientific area or subject

  matter);

  and if so, adding *(adding)* or removing *(deleting)* the designated

  prerequisite content entities to or from the list in accordance with the addition or

  removal of the selected content entity to add or remove the prerequisite content

  entities to or from the content object *(col. 14, lines 37-50, col. 16, line 55 - col.*

  17, line 45 -> once the professor CITbook 40 is generated from well-accepted

  knowledge determined by a community of experts, the same data-entry modules

60 used to receive, organize and categorize input data allow the professor to

create a student version of the CITbook for distribution to students in his/her

class ... by altering, adding and deleting any material existing in the primary

knowledge base of the professor CITbook 40 as well as adding personal topics).

As to claims 2, 7, and 12:

Mortimer teaches one or more of the prerequisites are conditional *(col. 15, line 52-col.*

16, line 12 -> a set of rules and restrictions with which inputted information must

comply).

As to claims 3, 8, and 13:

Mortimer teaches the conditions for applying a prerequisite are defined in one or more

rules *(col. 8, lines 18-51 -> a set of predefined data-entry rules 74 or specifications for*

the document-entry process. The rules include specifying a selected data format which

the data must comply with before it is accepted by the interactive system. The data-entry

rules provide for formatting, organizing, categorizing and integrating the inputted

material into a professor CITbook ... rules 74 also include categorization rules which

determine the category of each portion of entered text such as "Subject Matter," "Topic,"

"Chapter Title," and "Education Level." Categorization is performed for example by

searching for key words or requesting the data-entry person to identify the material).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a),
the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions
covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37
CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35
U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 4-5, 9-10, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Mortimer et al.** in view of **Tabuchi** (U.S. 6,606,633, filed 09/1999).

As to claims 4, 9 and 14:

Tabuchi teaches in the case of more than one of the rules pertaining to the same

prerequisite, further comprising the step of reducing the rule set if possible into a smaller

set of rules *(col. 4, lines 4-60, col. 10, line 59-col. 11, line 36 & see fig.5 and the

associated text).*

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify Mortimer with Tabuchi because it would have provided

the capability for checking a possibility/impossibility of relating of a data object with

reference to the structuring rule table, and the compound document object, when newly

relating to other object, inquires of the rule searching means whether relating of the

objects in a desired relation is possible or not.

As to claims 5, 10 and 15:

Tabuchi teaches the step of rewriting any negative rules as positive rules *(col.11, lines*

23-37 -> whether a structuring rule is being used in a compound document object or can

not be recognized ... when the number of references of the designated structuring rule is

not 0, the structuring rule in question will not be deleted).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify Mortimer with Tabuchi because it would have provided

the capability for checking a possibility/impossibility of relating of a data object with

reference to the structuring rule table, and the compound document object, when newly

relating to other object, inquires of the rule searching means whether relating of the

objects in a desired relation is possible or not.

Response to Arguments

6.   Applicant's arguments filed 10/05/2007 have been fully considered but they are not

persuasive.

Applicant argues that Mortimer does teaches the claimed *"examining the stored designations, determining if a selected object has any prerequisite objects designated for the selected object and adding or removing the designated prerequisite objects to a content object"* [Remarks, page 10].

In response, Mortimer's teaching *"data including text, images, illustrations, simulations, audio and video for inclusions ... determine which portions of the collected data are well-accepted among experts in the relevant field. The well-accepted data includes data which is believed to be "true" at the time of review and of course includes established proven theories and topics. The set of well-accepted data is considered the "truth" in the relevant field of study and forms a primary knowledge base of the professor CITbook 40. Preferably, a separate professor CITbook 40 is generated for each selected scientific area or subject matter"(see* Mortimer ; *col. 7, lines 38-62; col. 8, lines 39-51; and col.13, lines 18-32)* is interpreted as read-on the limitation *"examining the stored designations, determining if a selected object has any prerequisite objects designated for the selected object and adding or removing the designated prerequisite objects to a content object"* as claimed.

Applicant further argues that Mortimer does not teach *defining a content object by a list indicating the user specified content* [Remarks, page 10, lines 18 -19].

In response to applicant's arguments, the recitation *"defining a content object by a list*

indicating the user specified content" has not been given patentable weight because the

recitation occurs in the preamble. A preamble is generally not accorded any patentable

weight where it merely recites the purpose of a process or the intended use of a structure,

and where the body of the claim does not depend on the preamble for completeness but,

instead, the process steps or structural limitations are able to stand alone. See In re Hirao,

535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88

USPQ 478, 481 (CCPA 1951). However, even if this limitation is given patentable

weight it is met by Mortimer *(see the Abstract and col. 6, lines 15-22)*.

Conclusion

7.   The prior art made of record, listed on PTO 892 provided to Applicant is considered to

have relevancy to the claimed invention. Applicant should review each identified

reference carefully before responding to this office action to properly advance the case in

light of the prior art.

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the mailing date of this final action.

Contact information

9. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-

4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN

WILLIAM BASHORE
PRIMARY EXAMINER